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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,867	12/21/2001	Chan U. Ko	AVERP2997USA	4665
7590	05/05/2005		EXAMINER	
William C. Tritt			CHANG, VICTOR S	
Renner, Otto, Boisselle & Sklar, LLP				
Nineteenth Floor			ART UNIT	PAPER NUMBER
1621 Euclid Avenue			1771	
Cleveland, OH 44115-2191				DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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MV

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/028,867	KO ET AL.
	<b>Examiner</b> Victor S. Chang	<b>Art Unit</b> 1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 10-24 and 28-34 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 7-9, 25-27, 35 and 36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 3/3/2005. Applicants' amendments to claims 1 and 35 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-3, 7-9, 25-27, 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that independent claims 1 and 35 have been amended to recite, *inter alia*, "having a molecular weight greater than 6000" and "having a weight average molecular weight greater than 6000", respectively. Applicants state that "[s]upport for the amendment is found on page 3 lines 1-16 of the specification and in Examples 1-13

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... wherein Palamoll 656 is used as the second plasticizer. Applicants have submitted a copy of BASF Technical Leaflet for Palamoll 656 and a copy of the Australian government's Full Public Report for BASF Palamoll 656 which recites on page 3 the weight average molecular weight of 6396." (Remarks, page 7, last full paragraph). However, it is noted that these documents disclose that Palamoll 656 is a polymer of "hexanedioic acid, polymer with 1,4-butanediol, 1,3-propanediol, 2,2-dimethyl and isononanol" (see page 2 of the Australian report). As such, the composition of Palamoll 656 is not commensurate with the elected plasticizer species of "a terpolymer of an olefin, a comonomer selected from (meth)acrylic acids or ester and vinyl acetates, and carbon monoxide" (see response dated 10/19/2004, page 7), because clearly Palamoll 656 does not comprise any of the three required monomers of the elected terpolymer. In other words, the provided documents fail to provide support for the newly added element of "weight average molecular weight of 6000", and the amendment appears to be new matter. Applicants are required to cancel the new matter in the next reply.

***Rejections Based on Prior Art***

4. Claim 1-3, 7, 9, 25-27, 35 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 59105045 A (English abstract and translation PTO 05-3174), generally as set forth in section 6 of Office action dated 12/6/2004, together with the following additional reasoning and response to argument.

Applicants' argument "JP '045 does not disclose ... elongation of at least about 50% and a thickness from about 1 to about 20 mils. Furthermore, the plasticizer described in the JP '045 Abstract has a significantly lower molecular weight (MW 1,200-3,000) than the plasticizer of the present invention (MW .6,000)" has been carefully considered, but is not persuasive. First, regarding the thickness, the Examiner notes that newly provided full translation of JP '045, i.e., PTO '174, confirms that JP '045 teaches a 0.2 mm thick transparent flexible sheet in Example 1, and reads upon the instantly claimed thickness, Applicants argument to the contrary notwithstanding.

Second, regarding the molecular weight of the terpolymer plasticizer, in addition to being a possible new matter, as set forth above, it should be noted that JP '045 does teach the same terpolymer composition as claimed, and the particular molecular weight of 1,200-3,000 is merely an exemplary commercially available product, nowhere does JP '045 expressly or inherently teach that the molecular weight of the exemplary terpolymer is a limiting element. As such, in the absence of evidence to the contrary, since JP '045 teaches the same subject matter (a flexible vinyl halide film, and the same polymer/plasticizer blend composition) as the instant invention, it is the Examiner's position that selecting a plasticizer having a suitable molecular weight is either anticipated by JP '045, or obviously provided by practicing the invention of the prior art. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. Third, with respect to the

elongation of the plasticized vinyl halide film, the Examiner repeats (see Office action dated 12/6/2004) that since JP '045 teaches the same subject matter, as set forth above, a suitable elongation of the flexible sheet is either anticipated by JP '045, or an obviously provided once the product is made. Finally, it is noted that Table 2 of PTO '174 also shows that all the test samples having elongation greater than 300%.

With respect to Applicants' argument "The film of JP '045 is disclosed as being a non-rigid sheet that is molded." (Remarks, page 8, top paragraph), the Examiner repeats that JP '045 discloses all the structural and compositional elements of instant invention as claimed, and in the absence of any evidence that the process of instant invention imparts distinct structural and/or compositional features/characteristics to the film, the method disclosed by JP '045 is immaterial to the patentability. It should also be noted that the process of the instant invention is not recited in any claims.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 59105045 A (English abstract and translation) in view of Green et al. (US 3973563), generally as set forth in section 7 of Office action dated 12/6/2004, together with the response to argument as set forth above.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*  
Victor S Chang  
Examiner  
Art Unit 1771

4/6/2005

*CHERYL A. JUSKA*  
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PRIMARY EXAMINER